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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,783	01/24/2000	Richard C. Johnson	ORCL5628	7640

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EXAMINER

KAPADIA, MILAN S

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/490,783

Applicant(s)

JOHNSON, RICHARD C.

Examiner

Milan S Kapadia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 06 November 2002. Claims 1-28 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 5, 7-11, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiden et al. (6,055,520).

(A) As per claim 1, Heiden teaches a method of enabling anonymous shipment of a package containing goods purchased by a customer from a third party for delivery to an address unknown to the third party:

receiving a request for a package code for the package from the third party
(Heiden; col. 7, lines 1-40; the examiner interprets the "party who controls the host system" as the "third party");

sending the package code to the third party, the package code being devoid of delivery address information (Heiden; col. 7, lines 1-40l);

sending a shipping identifier and an associated address to the shipper, whereby the shipper, after picking up the package for shipment from the third party, matches the package code sent to the third party with the shipping identifier and identifies the associated address as the delivery address of the package (Heiden; col. 2, line 51-col. 3, line 16 and col. 6, lines 35-67).

Heiden fails to expressly teach the third party as being a vendor. However, Heiden does suggest that an embodiment of the invention can be used to have vendors ship items directly to its customers (Heiden; col. 1, lines 38-43). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Heiden to incorporate this limitation, with the motivation of enabling vendors to ship directly to its customers without disclosing the identity of the customers to the vendors (Heiden; col. 1, lines 38-43).

(B) As per claims 2, 4, and 5, Heiden teaches wherein the package code includes at least one of a code number and machine-readable indicia representing the code number and wherein the receiving and sending steps are performed over a computer network which includes at least one of leased lines, a private network, a virtual private network and the Internet (Heiden; col. 7, lines 9-16 and 22-24 and col. 8, lines 41-47).

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(C) As per claim 7, Heiden teaches a method of processing a package identified by a package code, the package containing goods purchased by a customer from a third party for shipment to an address comprising the steps of:

- picking up the package from the third party (Heiden; col. 6, lines 35-51);
- reading the package code affixed to the package (Heiden; col. 6, lines 35-51);
- matching the package code with the received shipping identifier, and
- delivering the package to the delivery address associated with the shipping identifier (Heiden; col. 6, lines 35-67).

Heiden fails to expressly teach the third party as being a vendor. However, Heiden does suggest that an embodiment of the invention can be used to have vendors ship items directly to its customers (Heiden; col. 1, lines 38-43). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Heiden to incorporate this limitation, with the motivation of enabling vendors to ship directly to its customers without disclosing the identity of the customers to the vendors (Heiden; col. 1, lines 38-43).

Heiden teaches receiving a request including a shipping identifier and a delivery address (Heiden; col. 7, lines 9-23) but fails to expressly teach receiving a request to pick up a package from the vendor, the package having a package code affixed thereto. However, since Heiden teaches that the package is picked up by the postal service and the package having a package code affixed thereto (Heiden; col. 51-63), it is respectfully submitted, that it would have been obvious, to one having ordinary skill in

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the art at the time the invention was made, to expand the system taught by Heiden to request the postal service to pick up a package from the vendor, the package having a package code affixed thereto, with the motivation of notifying the postal service when the package was ready for delivery.

(D) As per claim 8, Heiden teaches the steps of printing a shipping label on which the delivery address is visible and affixing the shipping label on the package (Heiden; col. 6, lines 59-67).

(E) Claims 9-11 repeat the limitations of claims 2, 4, and 5, respectively, and are therefore rejected for the same reasons given above in the rejection of claims 2, 4, and 5 and incorporated herein.

(F) Claim 13 repeats the features of claims 1 and 7 and is therefore rejected for the same reasons given above in the rejections of claims 1 and 7 and incorporated herein (Also note Heiden; col. 1, lines 51-67, col. 6, lines 35-67, and col. 7, lines 1-24).

(G) Claims 14-16 repeat the limitations of claims 2, 4, and 5 and are therefore rejected for the same reasons given above in the rejection of claims 2, 4, and 5 and incorporated herein.

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4. Claims 3, 6, 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiden et al. (6,055,520 as applied to claims 1, 7, and 13 above and further in view of Shkedy (6,260,024).

(A) As per claim 3, Heiden fails to expressly teach wherein the received request includes at least one of a request for authentication and an electronic draft for payment of at least one of the purchased goods and a shipping charge. However, this feature is old and well known in the art, as evidenced by Shkedy's teachings with regards to wherein the received request includes at least one of a request for authentication and an electronic draft for payment of at least one of the purchased goods and a shipping charge (Shkedy; col. 5, line 61-col. 6, line 3, col. 6, lines 29-40, and col. 21, lines 25-45). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Heiden with Shkedy's teaching with regards to this limitation, with the motivation of guaranteeing payment to the seller and verifying the identity of the buyer (Shkedy; col. 3, lines 13-23).

(B) As per claim 6, Heiden fails to expressly teach wherein the receiving and sending steps are carried out by a bank. However, this feature is old and well known in the art, as evidenced by Shkedy's teachings with regards to wherein the receiving and sending steps are carried out by a bank (Shkedy; col. 25, lines 31-61). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the

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time the invention was made, to expand the system taught by Heiden with Shkedy's teaching with regards to this limitation, with the motivation of providing third parties that can insure both buyers and sellers against fraud (Shkedy; col. 25, lines 58-60).

(C) Claims 12 repeats the limitations of claim 6 and is therefore rejected for the same reason given above in the rejection of claim 6 and incorporated herein.

(D) Claims 17 repeats the limitations of claim 6 and is therefore rejected for the same reason given above in the rejection of claim 6 and incorporated herein.

5. Claims 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy et al. (6,260,024) in view of Heiden et al. (6,055,520).

(A) As per claim 18, Shkedy teaches a method of enabling a customer to anonymously purchase an item from a vendor via an electronic draft for delivery to an address comprising the steps of:

storing, in a bank, an encrypted unique identifier for the customer, the encrypted unique identifier being linked to the customer's personal and financial information stored in the bank, including the delivery address (Shkedy; col. 10, lines 1-10 and col. 21, lines 24-44, and col. 25, lines 31-61);

authenticating the customer having caused a draft to be executed for payment of at least one of a purchase price of the item and a shipping cost by encrypting at least a

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portion of an identification data provided by the customer and successfully matching the encrypted identification data with the stored encrypted unique identifier (Shkedy; col. 21, lines 25-44);

retrieving at least the authenticated customer's financial information (Shkedy; col. 5, line 61-col. 6, line 3);

honoring a draft presented by the vendor for payment of the item only when the customer is successfully authenticated by the bank (Shkedy; col. 6, lines 29-39);

Shkedy fails to expressly teach retrieving at least the authenticated customer's delivery address, assigning a package code to the item, the assigned package code being associated with the retrieved delivery address, sending the package code to the vendor, the vendor affixing the package code to the package, and whereby the shipper picks up the item from the vendor, and prints out a shipping label for the package, a delivery address on the label being that customer address linked to a package code stored in the shipper database that matches the package code affixed to the package. However, this feature is old and well known in the art, as evidenced by Heiden's teachings with regards to retrieving at least the authenticated customer's delivery address (Heiden; col. 6, lines 35-58), assigning a package code to the item, the assigned package code being associated with the retrieved delivery address (Heiden; col. 7, lines 16-24), sending the package code to the vendor, the vendor affixing the package code to the package (Heiden; col. 7, lines 16-24), and whereby the shipper picks up the item from the vendor, and prints out a shipping label for the package, a delivery address on the label being that customer address linked to a package code

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stored in the shipper database that matches the package code affixed to the package (Heiden; col. 6, lines 35-67). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Shkedy with Heiden's teaching with regards to these limitations, with the motivation of producing package labels without disclosing the delivery address to the party producing the package (Heiden; col. 1, lines 44-48).

Shkedy and Heiden collectively fail to expressly teaching sending the package code and associated delivery address to a shipper for storage in a shipper database. However since the combined system of Shkedy and Heiden clearly teach a shipper sending a package having an associated package code and delivery address (Heiden; col. 6, lines 59-67) and a database containing package codes and delivery addresses (Shkedy; col. 10, lines 1-10, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Shkedy and Heiden to send the package code and associated delivery address to a shipper for storage in a shipper database, with the motivation of providing the delivery address of where the package should be sent to the shipper.

(B) As per claim 19, Shkedy teaches the identification data includes at least one of an ID and a password, the password being known to the bank only in encrypted form, biometric data and a digital certificate (Shkedy; col. 4, line 66-col. 5, line 7).

(C) As per claim 20, Shkedy teaches the customers' encrypted unique identifier,

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personal and financial information are stored in a data structure managed by a Directory software controlled by the bank (Shkedy; col. 9, lines 33-47).

(D) As per claim 21, Shkedy and Heiden collectively fail to expressly teach wherein the package code and the linked customer address are replicated in the shipper address via Light Weight Directory Access Protocol (LDAP)). However, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Shkedy and Heiden with regards to this limitation, with the motivation of preventing the loss of data by providing a backup up copy with a commonly known method of accessing data.

(E) As per claim 22, Shkedy and Heiden collectively fail to expressly teach at least portion of the shipper database is replicated in a portable electronic device equipped with a package scanner and a shipping label printer. However, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Shkedy and Heiden with regards to this limitation, with the motivation of enabling the matching to be done remotely.

(F) As per claim 23, Shkedy fails to expressly teach wherein the package code

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includes at least one of a code number and machine-readable indicia representing the code number. However, this feature is old and well known in the art, as evidenced by Heiden's teachings with regards to wherein the package code includes at least one of a code number and machine-readable indicia representing the code number (Heiden; col. 7, lines 9-16 and 22-24). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Shkedy with Heiden's teaching with regards to this limitation, with the motivation of producing package labels without disclosing the delivery address to the party producing the package (Heiden; col. 1, lines 44-48).

(G) As per claims 24 and 25, Shkedy teaches wherein the authenticating and sending steps are performed over a computer network that includes the Internet (Heiden; col. 8, lines 55-65).

(H) As per claim 26, Shkedy and Heiden collectively fail to expressly teach wherein the customer is a business. However, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Shkedy and Heiden with regards to this limitation, with the motivation of enabling the system to work with the diverse set of customers in the market for purchasing products and services.

(I) Claim 27 differs from claim 18 by reciting the associated delivery address as an

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electronic address, the product comes in a digital form, and the vendor forwarding the goods to a different electronic address. As per these limitations, Shkedy teaches an embodiment of his system can be used with electronic email addresses and used to exchange digital files, graphics, video, and audio (Shkedy; col. 10, line 54-col. 11, line 7).

(J) As per claim 28, Shkedy teaches wherein the associating and storing steps are carried out by a bank (Shkedy; col. 25, lines 31-61).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches a system for sending gifts without knowledge of delivery address (Van Name, Mark L and Catchings, Bill, "Speed Is the Key To Online Selling Success," PC Week, December 14, 1998); traceable anonymous shipments (5,812,670); secure electronic transactions using a trusted intermediary (6,161,181); a system and method for secure presentment and payment over open networks (6,081,790); trusted agents for open electronic commerce (5,970,475); and a method and apparatus for cryptographically assisted commercial network system designed to facilitate buyer-driven conditional purchase offers (5,794,207).


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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Thursday, 8:30 A.M. to 6:00 P.M. In addition the examiner can be reached on alternate Fridays.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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DINH X. NGUYEN
PRIMARY EXAMINER

January 13, 2003